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08/818,520 03/14/97 FARQUHAR

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EXAMINER
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IM62/0611

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YAO, S	
ART UNIT	PAPER NUMBER

1733

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06/11/99

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/818,520**

Applicant(s)  
**Farquhar et al**

Examiner  
**Sam Chuan Yao**

Group Art Unit  
**1733**



☒ Responsive to communication(s) filed on Mar 14, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-23 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference number for energy director element 22 is missing from the figures. Correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 7-10, 15 and 18-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 7, the claim recitation of a finger raises an issue of New Matter. The original disclosure teaches providing metal covers having a plurality of fingers. There is no suggestion in the original disclosure of using a finger for the cover. If Applicant believes otherwise, it is suggested to cite a passage or passages to provide support on the newly claimed subject matter.

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In claim 15, this claim raises an issue of New Matter for the same reason as claim 7.

In claim 18, the claim recitation of "U-shape" raises an issue of New Matter. The original disclosure fails to teach providing metal covers having an edge forming a U-shape. It is suggested for Applicant to cite a passage or passages to provide support on the newly claimed subject matter. It is interesting to note that as clearly shown in figure 4, the edge portion of the metal covers are bent toward the base of the metal covers thus intrinsically does not form a U-shape edge (see the fingers).

In claims 19 and 21, the claims recitation of "a plane bisecting the U-shaped edge ..." raise an issue of New Matter. The original disclosure fails to teach the presently claimed subject matter. It is suggested for Applicant to cite passage or passages which provide support to the presently claimed subject matter.

In claims 22-23, the claims recitation of "the frame element is injection molded partially around the edge" (emphasis added) raise an issue of New Matter. The original disclosure fails to teach the presently claimed subject matter. It is suggested for Applicant to cite passage or passages which provide support to the presently claimed subject matter.

4. Claims 7-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification:

a) while being enabling for covers secured to the frame elements by fingers embedded in the frame elements through injection molding, does not reasonably provide enablement for securing a finger to the frame element as recited in claim 7. The specification does not enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. The specification only discloses covers and frame elements secured together by fingers embedded in the frame elements by injection molding. It is noted that Applicant, on Paper No. 6 dated 08-08-94 in S.N. 08/092,012 (the parent of this reissue application), argues that the "... the chief advantages of the present invention is that it facilitates the bonding of two dissimilar materials, plastic and metal. ... uses a unique injection molding ... The technique includes the use of protruding metallic fingers on the cover ... are embedded in the plastic frame itself. The present invention accomplishes this by means of the multiple fingers 26 ... injection molding is used to provide a plastic frame 16 and 18 that envelope the fingers." (emphasis added). Since the fingers and the injection molding of the frame elements are critical or essential to the practice of the invention (as evidence from Applicant's argument and the original disclosure taken as a whole), but not included in this claim (fingers), this claim is not enabled by the disclosure.

b) while being enabling for covers secured to the frame elements by fingers embedded in the frame elements through injection molding, does not reasonably provide enablement for securing an edge (without the recitation of fingers) extending from each of the covers to the frame element as recited in claim 11. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims for essentially the same reason as above.

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c) while being enabling for covers secured to the frame elements by fingers embedded in the frame elements through injection molding, does not reasonably provide enablement for securing a U-shape edge extending from each of the covers and one of the frame elements is injection molded, while the other is molded. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims for substantially the same reason as above.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10, 12, 14 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it is unclear what is intended by the limitation "... extends beyond the plane of the metal covers ...". Which "plane" of the metal covers is the applicant referring to? Is "the plane of the metal covers" referring to a horizontal plate portion above a base plate portion of the metal covers and substantially parallel to the horizontal metal-to-metal contacting portion of the covers **or** the bent portion at the edge of the covers (i.e. fingers). Note further that "the plane" does not have a proper antecedent basis.

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Claim 12 is indefinite for the same reason as claim 1 above.

Claim 14 is indefinite because it is unclear what the term "energy director" reads on. Is "energy director" a term of the art? If so, it is suggested for Applicant to cite a reference. For the purpose of examining this claim, it is assumed that the "energy director" is the protrusion (20) shown in figures 2.

Claim 19 is indefinite because it is unclear which plane bisect "the U-shape edge at its terminal portion" of the metal covers.

Claim 20 is indefinite for the same reason as claim 14.

### ***Double Patenting***

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1-23 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 16-49 of copending Application No. 09/023,780. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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*Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

10. Claims 11-13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Simmons et al (US 5,339,222).

Simmons et al discloses a PCM holder comprising a pair of contoured metal covers (taken to be stamped metal covers), each having an edge of each side of the cover; and a plastic frame element securing the pair of covers (figure 5).

Although Simmons et al does not teach providing a plastic frame element for each of the covers and wherein each plastic frame element is injection molded, it is taken that the resultant PCM holder is indistinguishable from the one recited in the claim because the plastic frame elements for the covers will fuse together during the injection molding of the frame elements so that no distinguishing demarcation interface is going to be formed. Furthermore, it is also acknowledge that Simmons et al does not teach injection molding the frame elements. However, the resultant PCM holder of Simmons et al is indistinguishable from the one recited in these



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claims. It is now well settled, "If the product in the product by process claim is the same as or obvious from the product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 777 f.2d 695,698,227 USPQ 964 966 (Fed. Cir. 1985). According to MPEP 2113, "The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). MPEP 2113 further states that once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802,218 USPQ 289, 292 (Fed. Cir. 1983). Furthermore, "Even though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production."

With respect to claims 12-13 and 17, the limitations in these claims are inherent in the PCM holder of Simmons et al.

***Reissue Applications***

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11. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

12. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

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13. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

14. The reissue oath/declaration filed with this application is defective because Applicant's reason for filing a reissue application is not consistent or commensurate with the scope of claims 11-14 and 16-23.

On paragraph 27 of the declaration, Applicant states that "It was my unintended mistake ... the claim could be effectively written to read on the preferred embodiments of my invention in which a finger extends from each of the metal covers ..." (Emphasis added). However, none of these claims require a finger extending from each metal cover.

15. Claims 1-23 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action.

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16. Claims 11-23 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In an examiner's amendment in S.N. 08/092,102 (the parent of this reissue application), a limitation that the metal covers are bent to conform to the shape of the frame was added to claim 1. In addition, in amendment B in Paper No. 6 dated 08-08-99, in response to Examiner's office action, Applicant amended the claim to include "the plastic frame elements being injection molded around a plurality of fingers" and then argues on pages 3-4 the criticality of injection molding to the invention. These claims do not, however, include the above limitations, and as such are an improper recapture of claimed subject matter deliberately canceled.

17. The amendment is objected because it fails to provide an explanation of the support in the disclosure for each amendment (non-editorial) with comments on pages separate from pages containing amendments as required by 37 C.F.R. 1.121(b)(2)(iii).


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Sam Chuan Yao** whose telephone number is

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(703) 308-4788. The examiner can normally be reached on Monday-Thursday from 8:00 AM-5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mike Ball, can be reached on (703) 308-2058. The **fax number** in Group Art Unit 1733 for any official papers (i.e. papers that will be entered as part of the file wrapper) is (703) 305-7718 and for unofficial papers (e.g. proposed amendments) is (703) 305-7115.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

  
Sam Chuan Yao  
Primary Examiner  
Art Unit 1733

scy

June 9, 1999